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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Andrew D. Dubner, et al. Confirmation No. 4391  
Serial No.: 09/846,632 Examiner: Willmon Friddle Jr.  
Filed: May 1, 2001 Art Unit: 3722  
Docket: 56650US002  
Title: TRANSPARENT TAMPER-INDICATING DATA SHEET

**MS Appeal Brief-Patents**  
Commissioner for Patents  
P.O. BOX 1450  
Alexandria, VA 22313-1450

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Docket No.: 56650US002

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Andrew D. Dubner, et al.

Application No.: 09/846,632

Confirmation No: 4391

Filed: May 1, 2001

Art Unit: 3722

For: Transparent Tamper-Indicating  
Data Sheet

Examiner: Willmon Fridie Jr.

**APPELLANT'S BRIEF**

MS Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This brief, in compliance with 37 C.F.R. § 41.37, is in furtherance of the Notice of Appeal filed under 37 C.F.R. § 41.31 on May 11, 2006.

The fees required under § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

The final page of this brief bears the attorney's signature.

## **I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is 3M Innovative Properties Company a corporation established under the laws of the State of Delaware and having a principle place of business at P.O. Box 33427, St. Paul, Minnesota 55133.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any related appeal or interference.

## **III. STATUS OF CLAIMS**

The Claims 1-27 are pending. No claims are allowed. Claims 1-27 stand rejected and are the subject of this appeal.

## **IV. STATUS OF AMENDMENTS**

Appellant filed a Response after Final Rejection on March 13, 2006 (hereinafter "Final Response") with no claims amended, added, or cancelled. The Appellant filed a Notice of Appeal on May 11, 2006.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

### **Independent Claim 1**

Independent claim 1 recites a transparent data sheet that includes a transparent durable layer, a transparent fragile layer, and at least one security element, where printed identification and/or verification information is provided on one of the transparent durable layer and the transparent fragile layer, and the two layers are laminated together.

The transparent data sheet includes components that are laminated together with or without an adhesive layer between the two major components (the transparent durable layer and the transparent fragile layer) (page 2, lines 19-21, Figures 1 and 2). The transparent durable layer and the transparent fragile layer can have more than a single component or layer (page 2, lines 30-31; page 5, lines 3-5, figure 2).

The transparent data sheet can also include at least one security element, or feature, that allows for the destruction of the fragile layer to indicate tapering or attempted delamination (page 3, lines 26-28). Examples of the security elements include

holograms and other diffractive optically variable images, embossed images, color-shifting films, images visible under certain conditions such as inspection under light of a certain wavelength, polarized light, or retroreflected light (page 3, lines 26-32).

The term transparent "fragile" layer includes a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing (page 2, lines 24 - 26; page 6, lines 7-9). Examples of the transparent fragile layer include a holographic foil, a high refractive index layer and a protective coating, security laminate, polyurethane films including multilayered polyurethane films, glass beads in a beadbond layer, optical stacks, or other material or film that is mechanically weak (page 3, lines 4-5; page 4, lines 21-23; page 5, lines 19-24; page 6, lines 10-14).

The term transparent "durable" layer includes a film or material that is a free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures as well as repeated handling (page 2, lines 26 - 29; page 9, lines 25-28). Examples of the transparent durable layer include polyester, multilayer optical film, polypropylenes such as biaxially oriented polypropylene, poly(ethylene terephthalate), polycarbonates, polyimides, cellulose acetate, polyethylene naphthalate, and among others (page 2, lines 15-16; page 5, lines 12-14; page 9, lines 29-30). The transparent durable layer can also be constructed with a combination of the listed films (page 5, lines 17-18).

Figure 1 provides an illustration of the "transparent data sheet 10" that includes "a durable film 11, printed indicia 12, an adhesive layer 13 and a holographic foil 14" (page 5, lines 10-12). Figure 2 provides an additional embodiment of a transparent data sheet "20" that includes a "durable film 21, printed indicia 22, an adhesive layer 23, a holographic foil 24, and a high refractive index coating 26" (page 5, lines 25-28).

### Independent Claim 2

Independent claim 2 recites a transparent data sheet that includes a transparent fragile layer, a second transparent fragile layer, and at least one security element, where printed identification and/or verification information is provided on one of the two

transparent fragile layers, and the two layers are laminated together to form a laminate, wherein the laminate is durable.

The use of a first transparent fragile layer and a second transparent fragile layer to form a laminate that is durable can include a holographic foil and a layer of glass beads embedded in a layer of beadbond (page 3, line 11-16). Figure 3 provides an example of a "transparent sheet 30" that includes "a fragile film (identified as a holographic foil) 34, an adhesive layer 33, printed indicia 32 and a second fragile layer 35 comprised of glass beads 37, a reflective coating 38 and a beadbond layer 36" (page 5, line 31 - page 6, line 3). "Additional security elements can be added to the second fragile layer 35 by adding printing on a predetermined array of glass beads 37, prior to the reflective coating 38" (page 6, lines 3-5).

The terms transparent "fragile" layer and security element are as described above for independent claim 1. The term durable is as described above for independent claim 1.

#### Dependent claim 3

Claim 3 is a dependent claim on independent claims 1 and 2 that recites that the transparent fragile layer is a holographic foil (page 2, lines 16-17; page 5, lines 10-12; page 6, line 15 - page 7, line 13).

#### Dependent claim 4

Claim 4 is a dependent claim on independent claims 1 and 2 that recites that the transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer (page 3, lines 13-16; page 5, lines 19-22; page 5, line 31 - page 6, line 3; and page 6, lines 10-12).

#### Dependent claim 5

Claim 5 is a dependent claim on independent claims 1 and 2 that recites that the transparent fragile layer is a foil (page 2, lines 16-17; page 5, lines 7-8, lines 10-12, lines 18-20, lines 25-28; page 5, line 31 - page 6, line 1; and page 6, lines 10-11, page 6, line 15 - page 7, line 13).

#### Dependent claim 6

Claim 6 is a dependent claim on independent claims 1 or 2 that recites that the transparent fragile layer is an optical stack (page 6, lines 10-13).

#### Dependent claim 15

Claim 15 is a dependent claim on independent claim 2 that recites that the second transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer (page 3, lines 11-16; page 5, lines 19-24; page 5, line 31 - page 6, line 3; page 6, lines 10-14; and page 7, lines 14-23).

#### Dependent claim 16

Claim 16 is a dependent claim on independent claim 1 that recites that the transparent durable layer is a multilayer optical film and the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer (page 2, lines 14-18; page 3, lines 15-16; page 5, lines 10-24).

#### Dependent claim 17

Claim 17 is a dependent claim on independent claim 2 that recites that the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer and the second transparent fragile layer is a holographic foil (page 3, lines 11-16; page 5, line 31 - page 6, line 5; and figure 3).

#### Dependent claim 18

Claim 18 is a dependent claim on independent claim 1 that recites that the transparent durable layer is a multilayer optical film and the transparent fragile layer is a holographic foil (page 2 lines 14-19; and page 5, lines 10-30; and figure 1 and 2).

#### Dependent claim 22

Claim 22 is a dependent claim on dependent claim 21 that recites the combination according to claim 21 where the document of value is an identification card (page 12, lines 17-19).

#### Independent claim 23

Independent claim 23 recites a process for manufacturing a transparent data sheet that includes providing a printable surface of a first fragile layer, providing a second layer, which is a durable layer or is a fragile layer, where the combination of the first and second layer provide a durable sheet, providing instructions to print on the printable surface of the first fragile layer; and assembling the first fragile layer and the second layer into the transparent data sheet, such that upon assembly, the two layers are laminated together (page 4, lines 6-11; and page 12; lines 11-16).

#### Independent claim 24

Independent claim 24 recites a process of manufacturing a transparent data sheet that includes printing identification information onto a surface of a first layer and laminating the printed surface of the first layer to another layer, where both layers are optically transparent and one layer is more fragile than the other (page 2, lines 14-23; page 4, lines 1-5 and 20-25; page 10, lines 4-10; and page 12, lines 2-7).

#### Dependent claim 25

Claim 25 is a dependent claim on dependent claim 19 that recites the printed identification and/or verification information is on the layer of hot melt adhesive provided on one of the transparent durable layer and the transparent fragile layer (page 3, lines 17-22; and page 8, line 4 – page 9, line 10).

#### Dependent claim 26

Claim 26 is a dependent claim on independent claim 1 that recites the at least one security element is associated with one of the transparent durable layer and the transparent fragile layer (page 3, lines 26-32; and page 6, lines 3-5).

#### Dependent claim 27

Claim 27 is a dependent claim on independent claim 2 that recites the at least one security element is associated with one of the transparent durable layer and the transparent fragile layer (page 3, lines 26-32; and page 6, lines 3-5).



## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The first issue is whether claims 1, 2, 9, 12, 13, 23 and 24 rejected under 35 U.S.C. § 103(a) are unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827).

The second issue is whether claims 3 and 5 rejected under 35 USC § 103(a) are unpatentable over Stephens as modified by Smith and further in view of Killey (U.S. Pat. No. 5,342,672).

The third issue is whether claims 4, 6-8, 10, 11, 14-16 and 19-21 rejected under 35 USC § 103(a) are unpatentable over Stephens as modified by Smith and further in view of McConville et al. (U.S. Pat. No. 4,968,063).

The fourth issue is whether claims 17 and 18 rejected under 35 USC § 103(a) are unpatentable over Stephens as modified by Smith as applied to claims 1, 2, 9, 12, 13, 23 and 24 above, and further in view of Killey and McConville.

The fifth issue is that no on the record basis for the rejection of claims 22, 26 and 27 has been presented by the Examiner.

## **VII. ARGUMENT**

### **REJECTIONS UNDER 35 U.S.C. § 103(a)**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

## Stephens

Stephens provides for a personal information packet to provide identification and relevant information to authorities in the event of an emergency (abstract). The personal information packet includes a folded information card bearing personal information on the shielded inwardly folded side of the card sealed within a transparent plastic envelope to secure the card against outward view of the personal information and against unauthorized removal of the card without breaching the sealed integrity of the envelope (abstract). Stephens provides that the transparent plastic envelope is laminated about the folded card to sealably enclose the card against outward view of the written information and to secure the card against removal without cutting open or otherwise breaching the sealed integrity of the envelope, with the notice and indicia being visible through the envelope (col. 2, lines 12-18).

Stephens provides that the "transparent plastic envelope 12" is securely sealed continuously along the perimeter of "the envelope 12" to securely enclose the card in sandwiched fashion between opposing outer plies of the envelope 12. Figure 2 of Stephens provides an illustration of the envelope 12 with its plies 12' and 12".

With respect to Stephens's use of 12' and 12" for the "envelope 12," MPEP 608.01(g) provides that in a detailed description "... no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification." In the present situation, the prime and double prime affixed to reference character "12" illustrate the "plies" (e.g., a layer) that go into forming the "envelope 12." So, Stephens uses the single reference character 12 with a prime and double prime to illustrate the same part in its unlaminated state (modification of part embodied in plies (i.e., layers) that have not yet been laminated together).

In support of this position, Stephens provides that:

... the plastic envelope 12 comprises dual rectangular plies 12',12" of a transparent thermoplastic material secured to one another along one corresponding edge either by folding together a single layer of rectangular plastic sheeting or preliminarily sealing the two plastic plies 12',12" together. As so configured, the two plies 12',12" of the envelope 12 are unattached along the remaining three sides,

enabling the folded card 16 to be easily inserted between the two plies 12',12", after which the plies 12',12" are sealably joined to one another, e.g., by a laminating process, over the entire perimeter of the envelope 12 laterally outward of the interior space occupied by the folded card 16, thereby to sealably and securely enclose the card 16 within the envelope 12 resulting in the finished packet 10 of FIG. 3. (Col. 3, lines 7-22).

As provided, Stephens teaches that the plies 12' and 12" are of a transparent thermoplastic material. Stephens does not appear to provide any additional teachings or suggestions that the plies 12' and 12" can be made of different materials, only from the same transparent thermoplastic material. In other words, the plies 12' and 12" that "form envelope 12" are of the same (i.e., identical) transparent thermoplastic material.

Stephens also provides that "... the envelope is formed with an opening for receiving a shoestring or other means for tying or similarly securing the packet to the body or clothing of the person, e.g., interlacing the packet in a child's shoestring." (col. 2, lines 19-23). It would appear that the transparent thermoplastic material of Stephens would have to be very tough and durable to withstand the environment in which the envelope is placed (e.g., a laced to a child's shoe). This characteristic of the plies 12' and 12" would appear to be supported by the teaching of Stephens that cutting lines are provided to show where to cut (e.g., with scissors) to open the envelope 12 (see col. 3, lines 33-41).

#### Claims 1, 2, 9, 12, 13, 23 and 24

Claims 1, 2, 9, 12, 13, 23 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephens (U.S. Pat. No. 5,380,046) in view of Smith (U.S. Pat. No. 5,410,827). Appellant respectfully traverses the rejection of the claims, and addresses their rejection as follows.

#### **Independent Claim 1**

Appellant respectfully submits that cited documents do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all the claim elements recited in claim 1. For example, Appellant is unable to find in Stephens and/or Smith a teaching or a suggestion of a transparent data sheet that includes, besides other things, a transparent durable layer and a transparent fragile layer, where printed

identification and/or verification information is provided on one of the transparent durable layer and the transparent fragile layer, and the two layers are laminated together, as recited in claim 1. In addition, Appellant respectfully submits that there is insufficient motivation to combine Stephens and Smith as asserted by the Examiner.

In the Final Office Action, the Examiner asserts that "Stephens discloses a security feature (16), a transparent fragile layer (12) and a transparent durable layer (12')." The Examiner then indicated that "[f]urther Stephens inherently teaches the method in claim 23 and 24 and substantially all of the subject matter set forth in the claims except for the claimed layer materials and indicia on one of its transparent layer," but that "Smith discloses that it is well known in the art to provide indicia on a transparent layer associated with an information bearing assembly (see column 2, lines 10-16)." Appellant respectfully traverses.

As discussed above, Stephens provides a "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material . . ." (Col. 3, lines 7-12). Stephens does not teach or suggest that these materials are structurally different (e.g., different thicknesses). Rather Stephens provides that the plies 12' and 12" are made of the identical transparent thermoplastic material. Stephens does not teach or suggest that the thermoplastic material is different for one ply relative another ply. So, it does not appear possible for Stephens' to teach or suggest that the "plastic envelope 12" is a "transparent fragile layer (12)", while one of the "plies 12'" is a "transparent durable layer (12')", as asserted by the Examiner.

In addition, it has not been clearly explained how it is possible to have the "plastic envelope 12" of Stephens be a "fragile layer", as asserted by the Examiner, while the ply 12', which forms one layer of the envelope 12, is asserted to be a durable layer. As discussed above, Stephen used a single reference character (i.e., 12) to reference the same part (a single thermoplastic material) that included two plies (i.e., 12' and 12") used to form the "envelope 12." It does not appear to be possible using the disclosure of Stephens for one skilled in the art to understand that the "envelope 12" can be a "transparent fragile layer (12)" while the ply "12'" that is used to form the "envelope 12" is a "transparent durable layer (12')" as asserted by the Examiner. Nor does it appear possible to using the disclosure of Stephens for one skilled in the art to understand that the plies 12' and 12" could have

different physical properties (e.g., durable versus fragile) when they are formed from the same thermoplastic material (same chemical properties) having no indication from Stephens that they have different physical properties (e.g., thicknesses). One skilled in the art would understand that the physical characteristics of the plies 12', 12" of the plastic envelope 12 would be identical (identical material provides identical properties). As such, Appellant respectfully submits that Stephens cannot be read so broadly as to reasonably assert that plies 12', 12" of the same exact material somehow have different physical characteristics.

Appellant further submits that there is insufficient motivation to combine the documents as asserted by the Examiner. First, Stephens lacks either an explicit or implicit problem to be solved. One skilled in the art reading Stephens would understand that if more information were need to be provided to a user (the asserted motivation to combine the cited documents), then more information could simply be supplied on the "information card 16" of Stephens. In addition, Stephens does not teach or suggest that there is a motivation to print additional information on either of the plies 12' or 12". Finally, as discussed above, one skilled in the art would easily recognize that if additional information were need to be supplied in the "personal information packet 10" provided by Stephens it could be simply supplied on the "information card 16."

Appellant respectfully submits that modification proposed by the Examiner would also both change the principle of operation of and render the "personal information packet 10" of Stephens unsatisfactory for its intended purpose. For example, Stephens provides that "[t]he notice appearing on the outward face of the information card 16 will be readily visible through the transparent envelope 12 to alert authorities to the availability of the personal information within the packet" (col. 3, lines 33-37). Modifying Stephens as suggested would provide printing on the plies 12', 12" of the plastic envelope 12 that would interfere with the "notice" of the "information card 16" being "readily visible through the transparent envelope 12" as provided by Stephens. In other words, printing on the plies would interfere with a person's ability to see the content of the "information card 16." As such, there would be no suggestion or motivation to make the proposed modification as asserted by the Examiner.

The Examiner also provided that:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any suitable material, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416

In essence, the Examiner asserts it is within one having ordinary skill in the art to select a suitable material based on the intended use of the material. As applied to Stephens, one skilled in the art would understand that other materials of identical physical characteristics (e.g., those rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [sic], etc." (Col. 3, lines 7-27)) could possibly be selected for this purpose. However, Appellant respectfully submits that this ability to select other suitable materials having identical physical characteristics does not include selecting materials having dissimilar characteristics (i.e., a transparent durable layer and a transparent fragile layer) as provided in claim 1.

As is appreciated, during examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

Appellant clearly recites the features upon which they rely in the claims. In addition, Appellant clearly defines and distinguishes the recited terms "durable" and "fragile" in the specification, where "[t]he term 'fragile' as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26), and "[a]s used in the application 'durable' means a film that is free-standing film, without the

necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling" (page 2, lines 26-29). These definitions provided by the Appellant are even consistent with secondary source definitions of "fragile" (1. Easily broken, damaged, or destroyed; frail. 2. Lacking physical . . . strength; delicate. 3. Lacking substance; tenuous or flimsy . . . ." The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 720) and "durable" (1. Capable of withstanding wear and tear or decay . . . 2. Lasting; stable . . . ." The American Heritage Dictionary of the English Language, Third Edition, 1992, p. 572).

In responding to the Appellant's argument, the Examiner has asserted that "it is noted that the features upon which applicant relies (i.e., the specifics of the 'durable' and 'fragile' layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181 26 USPQ2d 1057 (Fed Cir. 1993)."

As discussed above, Appellant expressly recites the terms "fragile" and "durable" in the claims, where these terms are clearly and expressly defined in the specification. This is in contrast to the facts in In re Van Geuns cited by the Examiner, in which Van Geuns tried to limit the phrase "uniform magnetic field" of a magnetic assembly recited in the claim to that of an NMR or MRI apparatus among others generally provided in the specification. In other words, Van Geuns tried to limit the phrase recited in the claim by narrowly reading its meaning from a broader recitation in the specification. As such, In re Van Geuns is distinguished from the present case, as Appellant is not trying to limit the interpretation the terms "fragile" and "durable," as was the case in In re Van Geuns.

In addition, Appellant respectfully submits that even if the Examiner maintains the assertion that the express definitions provided in the specification for "fragile layer" and "durable layer" cannot be read into the claim language, the plain meaning of the words "fragile" and "durable" (see above dictionary definitions for these words) for the layers recited in claim 1 distinguishes the claim over Stephens. This is because Stephens only teaches or suggests two plies (12' and 12") from the same material (i.e., the "plastic envelope 12"), rendering it impossible for Stephens to teach that a single material can provide in the same instance one layer that is "fragile" and one layer that is "durable."

The Examiner further asserts that "applicant has not disclosed any criticality to the use of a 'fragile' or 'durable' layer in his assembly." Appellant respectfully submits that they are unable to find a rule, law or discussion in the MPEP that disclosing the "criticality" of a claim element is a requirement of patentability. The MPEP does, however, discuss the situation where a claim that omits an element that applicant describes as an essential or critical feature of the invention would not comply with the written description requirement (see for example, MPEP 2163 I.B. and 2164.08(c)). The instant application, however, has not used the per se words "critical" or "essential" to describe an element in the specification. As such, Appellant is unaware of what rule or law, either substantive or procedural, the Examiner is submitting has not been met by the Appellant.

The Examiner then asserted that "[f]urther there is no recitation defining the function of the 'fragile' or 'durable' layer" (Final Office Action, page 5). It would appear that the Examiner is asserting that the present disclosure is lacking these recitations. Appellant respectfully traverses this assertion and submits that any number of recitations as to the function of the "fragile" and "durable" layer can be found through out the specification. For example, page 2, lines 24-26 provide that:

The term "fragile" as used in this application means a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing.

So, at least one "function" of the fragile layer, among others, is to be mechanically weak. In addition, page 2, lines 26-30 provide that:

As used in the application the term "durable" means a film that is free-standing film, without the necessity of a carrier layer and is thermally stable to withstand laminating or other processing temperatures, typically in the range of 100 to 150°C, as well as repeated handling, such as typical passport use.

So, at least one "function" of the durable layer, among others, is to be a free-standing film without the need for a carrier layer, and to be thermally stable to withstand laminating or other processing temperatures.



Appellant further provides that:

Advantageously, the present invention provides a transparent data sheet that contains one or more security features, including but not limited to the destruction of the fragile layer indicating tampering or attempted delamination. (page 3, lines 26-28)

So, an additional "function" of the fragile layer, among others, includes the ability to indicate tampering or attempted delamination of the transparent data sheet of the present disclosure.

In addition, the Examiner asserts that "[t]here is no recitation explaining its use in fraud detection or tampering" (Final Office Action, page 5). With respect to the instant patent application, Appellant respectfully submits that the words "fraud detection" are not recited in the pending claims. Appellant does, however, recite the word "tampering" in claim 19 to provide that the transparent data sheet further includes "a layer of hot melt adhesive that can not be re-used without evidence of tampering" (pending claim 19). Based on the plain language of the claim, the word "tampering" is used in conjunction with a layer of hot melt adhesive that can not be reused (e.g., the hot melt adhesive having been sealed is separated then rejoined) without evidence of tampering with the hot melt adhesive.

The Examiner also states that while "Stephens discloses two layers made of a thermoplastic material. It does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative durability." (Final Office Action, page 4). It appears that the Examiner is relying, at least in part, upon an inherency argument in rejecting the present claims. Appellant respectfully traverses.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (M.P.E.P. 2112, In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily

present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

First, Appellant respectfully submits that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. Second, the Examiner has provided no extrinsic evidence that would suggest, be recognized by, or made clear to one skilled in the art that the missing descriptive matter (e.g., the "different sections [that could] consist of different polymers to inherently provide layers of different/relative durability") is necessarily present in the "plastic envelope 12" that "comprises dual rectangular plies 12', 12" of a transparent thermoplastic material. Finally, it would appear that the Examiners assertions (e.g., "[i]t does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative durability") rely upon probabilities and/or possibilities, which are insufficient to support a proper inherency argument.

Based on the forgoing, Appellant respectfully submits that a proper rejection based on inherency has not been made.

With respect to Appellant's argument that there is no suggestion or motivation to combine the documents, the Examiner responded in the Final Office Action by asserting that "[i]n this case, all of the cited references are clearly in the field of endeavor of applicant's claimed invention." This assertion, however, does not address what explicit or implicit problem Stephens motivates one skilled in the art to solve, nor does it address what motivation is taught or suggested for one skilled in the art to print additional information on either of the plies 12' or 12" of Stephens.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in independent claim 1 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

### **Independent Claim 2**

Appellant respectfully submits that cited documents do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all the claim elements recited in claim 2. For example, Appellant is unable to find in Stephens and/or Smith a teaching or a suggestion of a transparent data sheet that includes, besides other things, a transparent fragile layer and a second transparent fragile layer, where the two layers are laminated together to form a laminate, where the laminate is durable. Rather, Stephens provides an "envelope 12" having "plies 12', 12"" of a transparent thermoplastic material, but does not teach or suggest that these plies are fragile layers that when laminated become durable, as provided in claim 2. In addition, Appellant respectfully submits that there is insufficient motivation to combine Stephens and Smith as asserted by the Examiner.

As discussed above for claim 1, Appellant uses the term "fragile" in the "transparent fragile layer" and the "second transparent fragile layer" to mean "a film or material that is mechanically weak and is typically constructed with a removable carrier layer for ease of handling or stability for printing" (page 2, lines 24-26). Appellant respectfully submits that the cited documents do not teach such a layer. Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [sic], etc." (Col. 3, lines 7-27). Stephens even provides that the information packet includes a "cutting line or lines along which to open the packet, e.g., by the use of scissors as shown in FIG. 4, to obtain access to the information." (Col. 3, lines 35-41). As such, Stephens does not teach or suggest both "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2.

Appellant further submits that there is insufficient motivation to combine the documents as asserted by the Examiner. Appellant respectfully repeats the arguments presented above for claim 1 in support of this position.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in independent claim 2 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

### **Dependent claims 9, 12 and 13**

As discussed above, Stephens does not teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. Stephens also does not teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens. As claims 9 and 13 are dependent claims of independent claims 1 and 2, and claim 12 is a dependent claim of independent claim 1, the §103 rejection of claims 9, 12 and 13 should be withdrawn.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in claims 9, 12 and 13 is not taught or suggested in cited documents. Therefore, the § 103 rejection should be withdrawn.

### **Independent claims 23 and 24**

For independent claims 23 and 24, the Examiner has asserted that "Stephens inherently teaches the method in claims 23 and 24 and substantially all of the subject matter set forth in the claims except for the claimed layer materials and indicia on one of its transparent layers. Smith discloses that it is well known in the art to provide indicia on a transparent layer associated in an information bearing assembly (see column 2, lines 10-16)." Appellant respectfully traverses as follows.

Appellant respectfully submits that Stephens and Smith do not support a proper prima facie case of obviousness as the documents, besides other things, do not teach or suggest all of the elements recited in claims 23 and 24. In addition, Appellant respectfully submits that there is insufficient motivation to combine Stephens and Smith as asserted by the Examiner.

Appellant respectfully submits Stephens does not teach or suggest, besides other things, a process for manufacturing a transparent data sheet that includes, besides other things, providing a printable surface of a first fragile layer and providing a second layer, which is a durable layer or is a fragile layer, where the combination of the first and second layer provide a durable sheet, as recited in claim 23. As discussed above for claims 1 and 2, Stephens teaches two plies 12' and 12" of the envelope 12, but does not teach or suggest a first fragile layer and a second layer, which is a durable layer or is a fragile layer, where

the combination of the first and second layer provide a durable sheet, as provided in claim 23. As a specific example, Stephens does not teach or suggest a "fragile layer," as recited in claim 23.

In addition, Appellant respectfully submits Stephens does not teach or suggest, besides other things, a process of manufacturing a transparent data sheet that includes printing identification information onto a surface of a first layer and laminating the printed surface of the first layer to another layer, where both layers are optically transparent and one layer is more fragile than the other. As discussed above for claims 1 and 2, Stephens teaches two durable plies 12' and 12" of the envelope 12, but does not teach or suggest that one ply is "more fragile than the other." Rather, Stephens teaches that the "plastic envelope 12 comprises dual rectangular plies 12', 12" of a transparent thermoplastic material" is rugged enough to be "laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack or bookbag [sic], etc." (Col. 3, lines 7-27). Stephens does not, however, teach or suggest that the plies have dissimilar properties. As such, Stephens does not teach or suggest all the elements recited in claim 24.

Appellant further submits that there is insufficient motivation to combine the documents as asserted by the Examiner. Appellant respectfully repeats the arguments presented above for claim 1 in support of this position.

In addition, Appellant respectfully submits that a proper rejection based on inherency has not been made. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis in original). Appellant respectfully submits, however, that the Examiner has provided no objective evidence or cogent technical reasoning to support the conclusion of inherency. As such, a proper rejection based on inherency has not been made.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in independent claims 23 and 24 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

### Claims 3 and 5

Claims 3 and 5 are rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of Killey (U.S. Pat. No. 5,342,672). Appellant respectfully traverses the rejection of the claims as follows.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Appellant respectfully submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a holographic foil or a foil) would render the "envelope 12" of Stephens unsatisfactory for its intended purpose. As discussed above, the intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with the holographic hot-stamp foil of Killey would defeat this purpose of the rugged transparent plastic envelope of Stephens as holographic foils and foils are known to be fragile.

Furthermore, Appellant respectfully submits that this proposed modification would further change the principle of operation of Stephens. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain,

bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with a holographic foil or a foil would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, Appellant respectfully submits the teachings of the references are not sufficient to render the claims 3 and 5 prima facie obvious.

In addition, Stephens and Smith do not teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens and Smith do not teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and/or Smith. Killey does not cure the above identified deficiencies of Stephens and Smith. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens, Smith and Killey, either independently or in combination. As claims 3 and 5 are dependent claims of independent claims 1 and 2, the § 103 rejection of claims 3 and 5 should be withdrawn.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in claims 3 and 5 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

#### Claims 4, 6-8, 10, 11, 14-16 and 19-21

Claims 4, 6-8, 10, 11, 14-16 and 19-21 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith and further in view of McConville et al. (U.S. Pat. No. 4,968,063). Appellant respectfully traverses the rejection of the claims as follows.

#### Dependent Claims 4, 6, 15 and 16

Appellant respectfully submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a retroreflective layer of glass beads in a beadbond layer or an optical stack) would render the "envelope 12" of Stephens

unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As discussed above, the intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with either the retroreflective layer of glass beads in a beadbond layer or an optical stack would defeat this purpose of the rugged transparent plastic envelope of Stephens as such structures are known to be fragile.

Furthermore, Appellant respectfully submits that this proposed modification would further change the principle of operation of Stephens. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with either glass beads in a beadbond layer or an optical stack would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, Appellant respectfully submits the teachings of the references are not sufficient to render the claims prima facie obvious.

In addition, Stephens and Smith do not teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens and Smith do not teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and/or Smith. McConville does not cure the above



identified deficiencies of Stephens and Smith. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens, Smith and McConville, either independently or in combination. As claims 4, 6, 15, and 16 are dependent claims of independent claims 1 and/or 2, the § 103 rejection of claims 4, 6, 15 and 16 should be withdrawn.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in claims 4, 6, 15 and 16 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

**Dependent claims 7, 8, 10, 11, 14 and 19-21**

As discussed above, Stephens and Smith do not teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens and Smith do not teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and/or Smith. McConville does not cure the above identified deficiencies of Stephens and Smith. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens, Smith and McConville, either independently or in combination. As claims 7, 8, 10, 11, 14 and 19-21 are dependent claims of independent claims 1 and/or 2, the § 103 rejection of claims 7, 8, 10, 11, 14 and 19-21 should be withdrawn.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in claims 7, 8, 10, 11, 14 and 19-21 is not taught or suggested in cited documents. Therefore, the § 103 rejection should be withdrawn.

**Claims 17 and 18**

Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1, 2, 9, 12, 13, 23 and 24 above, and further in view of Killey and McConville et al. Appellant respectfully traverses the rejection of the claims as follows.

Appellant respectfully submits that the modification proposed by the Examiner (where the transparent fragile layer of claims 1 and 2 is either a retroreflective layer of glass beads in a beadbond layer and/or a holographic foil) would render the "envelope 12" of Stephens unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As discussed above, the intended purpose of Stephens is to produce a personal information packet having a folded information card sealed within a transparent plastic envelope rugged enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies (e.g., 12' or 12") of the "envelope 12" of Stephens with either the retroreflective layer of glass beads in a beadbond layer and/or a holographic foil would defeat this purpose of the rugged transparent plastic envelope of Stephens as such structures are known to be fragile.

Furthermore, Appellant respectfully submits that this proposed modification would further change the principle of operation of Stephens. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this situation, Stephens's principle of operation appears to be to provide a rugged transparent plastic envelope containing a folded information card, where the transparent plastic envelope is tough enough be laced into a child's shoestring or, alternatively, carried on a neck chain, bracelet, knapsack, or book bag. Replacing one of the plies of this envelope with either glass beads in a beadbond layer or a holographic foil would change the principle operation as at least one of the plies would no longer be tough enough to withstand such rough treatment. This in turn would lead to the folded information card being either easily accessed or unintentionally separating from the envelope that is intended to protect the card until its use is needed.

Based on the forgoing, Appellant respectfully submits the teachings of the references are not sufficient to render the claims 17 and 18 prima facie obvious.

In addition, Stephens and Smith do not teach or suggest both a "transparent fragile layer" and a "transparent durable layer," as recited in claim 1. In addition, Stephens and Smith do not teach or suggest "a transparent fragile layer" and "a second transparent fragile layer," as recited in claim 2. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens and/or Smith. Killey and/or McConville do not cure the above identified deficiencies of Stephens and Smith. As such, each and every element of independent claims 1 and 2 is not taught or suggested in Stephens, Smith, Killey and McConville, either independently or in combination. As claims 17 and 18 are dependent claims of independent claims 1 and/or 2, the § 103 rejection of claims 17 and 18 should be withdrawn.

Based on the forgoing, Appellant respectfully submits that each and every element as recited in claims 17 and 18 is not taught or suggested in cited documents, and that there is insufficient motivation to combine the cited documents. Therefore, the § 103 rejection should be withdrawn.

#### Claims 22, 25, 26 and 27

Appellant's respectfully note that claims 26 and 27 were presented as new claims in their October 21, 2005 response to the August 10, 2005 Non-Final Office Action. The Advisory Action and Final Office Action, however, do not indicate that claims 26 and 27 are either pending or rejected. In addition, a basis for any rejection or non-entry of claims 26 and 27 to which the Appellant has had an opportunity to respond has not been made on the record.

Claims 22 and 25 were also indicated to be rejected on the Final Office Action summary sheet, but Appellant was not able to find the detailed basis for the claims rejection in the Final Office Action. Appellant respectfully requests consideration and allowance of claims 22, 25, 26 and 27.

Reconsideration and withdrawal of the § 103 rejection for the rejected claims are respectfully requested.

## VIII. CLAIMS APPENDIX

### The Claims on Appeal

1. (Previously Presented) A transparent data sheet comprising:  
a transparent durable layer,  
a transparent fragile layer, and  
at least one security element  
wherein printed identification and/or verification information is provided on one of the transparent durable layer and the transparent fragile layer, and the two layers are laminated together.
2. (Previously Presented) A transparent data sheet comprising:  
a transparent fragile layer,  
a second transparent fragile layer, and  
at least one security element  
wherein printed identification and/or verification information is provided on one of the two transparent fragile layers, and the two layers are laminated together to form a laminate, wherein the laminate is durable.
3. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a holographic foil.
4. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.
5. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a foil.
6. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is an optical stack.

7. (Original) The transparent data sheet according to claims 1 or 2 further including a high refractive index coating, coated on the outer surface of the transparent fragile layer.
8. (Original) The transparent data sheet according to claim 7 further including a protective coating, coated on the outer surface of the high refractive index coating.
9. (Original) The transparent data sheet according to claims 1 or 2 wherein the transparent fragile layer is a multilayered polyurethane film.
10. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is a multilayer optical film.
11. (Original) The transparent data sheet according to claim 10 wherein the multilayer optical film is comprised of at least one material that exhibits stress induced birefringence.
12. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is a polyester, polypropylene, polycarbonate, polyimide, or cellulose acetate.
13. (Original) The transparent data sheet according to claims 1 or 2, wherein the transparent fragile layer is comprised of more than one fragile material.
14. (Previously Presented) The transparent data sheet according to claim 1 wherein the durable layer is comprised of one or more durable layers.
15. (Original) The transparent data sheet according to claim 2 wherein the second transparent fragile layer is a retroreflective layer of glass beads in a beadbond layer.

16. (Previously Presented) The transparent data sheet according to claim 1 wherein the transparent durable layer is a multilayer optical film and the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer.

17. (Previously Presented) The transparent data sheet according to claim 2 wherein the transparent fragile layer is retroreflective layer of glass beads in a beadbond layer and the second transparent fragile layer is a holographic foil.

18. (Previously Presented) The transparent data sheet according to claim 1 wherein the transparent durable layer is a multilayer optical film and the transparent fragile layer is a holographic foil.

19. (Previously Presented) The transparent data sheet according to claims 1 or 2 further including a layer of hot melt adhesive that can not be re-used without evidence of tampering.

20. (Original) In combination:

- (a) transparent data sheet according to claims 1 or 2, and
- (b) a passport, wherein the transparent data sheet is inserted or otherwise attached to the passport.

21. (Original) In combination:

- (a) transparent data sheet according to claims 1 or 2, and
- (b) a document of value, wherein the transparent data sheet is inserted or otherwise attached to the document of value.

22. (Previously Presented) The combination according to claim 21 wherein the document of value is an identification card.

23. (Previously Presented) A process for manufacturing a transparent data sheet comprising:

providing a printable surface of a first fragile layer,

providing a second layer, which is a durable layer or is a fragile layer,

wherein the combination of the first and second layer provide a durable sheet, and

providing instructions to print on the printable surface of the first fragile layer; and

assembling the first fragile layer and the second layer into the transparent data sheet, such that upon assembly, the two layers are laminated together.

24. (Previously Presented) A process of manufacturing a transparent data sheet comprising:

printing identification information onto a surface of a first layer and

laminating the printed surface of the first layer to another layer, wherein both layers are optically transparent and one layer is more fragile than the other.

25. (Previously Presented) The transparent data sheet according to claim 19 wherein the printed identification and/or verification information is on the layer of hot melt adhesive provided on one of the transparent durable layer and the transparent fragile layer.

26. (Previously Presented) The transparent data sheet according to claim 1, where the at least one security element is associated with one of the transparent durable layer and the transparent fragile layer.

27. (Previously Presented) The transparent data sheet according to claim 2, where the at least one security element is associated with one of the transparent durable layer and the transparent fragile layer.

## IX. EVIDENCE APPENDIX

No evidence is submitted.

## X. RELATED PROCEEDINGS APPENDIX

As there are no appeals or interferences known to Appellant's Representatives which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. There are no copies of decisions rendered by a court or the Board to submit.

The Examiner is invited to telephone Applicants' attorney, Joseph C. Huebsch, at (612) 236-0122 with regard to this matter.

**CERTIFICATE UNDER 37 C.F.R. §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: **MS APPEAL BRIEF-PATENTS** Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on this 10<sup>th</sup> day of July, 2006.

Respectfully Submitted,  
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July 10, 2006  
Date: